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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Elias Castanas

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EXAMINER

LUKTON, DAVID

ART UNIT

PAPER NUMBER

1654

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action

The amendment filed 5/30/08 directs the cancellation of claims 31 and 51, and the amendment of claim 39. With entry of this amendment, claims 28-30, 32-50 and 52-61 will be pending. Also, with entry of this amendment, claims 28, 34, 48, 54, 60, 61 will be rejected; claims 29, 30, 32, 33, 35-47, 49, 50, 52, 53, 55-59 will be objected to.



Claims 28, 48, 60, 61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 of US Patent 7358379. Although the conflicting claims are not identical, they are not patentably distinct from each other. Applicants have stated that they intend to file a T.D. at some point in the future; accordingly, the rejection is maintained at the present time.



Claim 44 is objected to because of a minor grammatical error. This claim recites the following:

A method ... comprising administering to a patient in need thereof composition

The indefinite article ("a") should be present in front of "composition", i.e., the following:

A method ... comprising administering to a patient in need thereof **a** composition



Claims 34 and 54 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As indicated previously, claim 34 recites that it is the composition that is detectably labeled, rather than the steroid/protein conjugate itself. This raises questions as to what is meant. In traversing, applicants have completely sidestepped the issue of a

composition versus a compound (or conjugate). It is this distinction, however, that underlies the rejection. A composition is a mixture of two or more compounds, whereas a compound is just that, i.e., one compound. For example, if one had a composition that consisted of a mixture of aspirin and cellulose, and then proceeded to “detectably label” this mixture, what would that mean? Would it mean a covalent bond between the cellulose and the label, would it mean a ternary mixture of aspirin, cellulose, and the label, or would it mean something else?

In further traversing, it is suggested that applicants at least acknowledge the distinction between a compound and a composition, and then proceed to make arguments from there. Note that applicants were able to find a solution to this problem in claim 4 of USP 7,358,379.



Art Unit: 1654

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached at (571)272-0562. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

/David Lukton/

Primary Examiner, Art Unit 1654